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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,356	01/12/2001	Victor E. Acuna	459712000100	9304

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EXAMINER

LY, NGHI H

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 11/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/758,356

Applicant(s)

ACUNA, VICTOR E.

Examiner

Nghi H. Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 17 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 06/17/2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,3,10-12,13,17 are rejected under 35 U.S.C. 102(b) as being anticipated by Zicker et al (US 5,832,378).

Regarding claim 1, Zicker teaches a dual signaling channel telephone system, comprising: a wired signaling channel (see fig.1 number 24) including a central office (see fig.1 PSTN 20) and a telephone set (see fig.1 a telephone set connect to RJ-11 box,) to place and receive wire-line telephone calls (see fig.1 wire-line connection 24 between PSTN 20 and a telephone which connect with RJ11), a wireless signaling channel including a central platform (see fig.1 number 12), the central platform receiving (see fig.1 wireless connection between 10b and 26) messages from a message generator (see fig.1 number 23) independently operated from the telephone system (see fig.1 the wire-line connection 24 between PSTN 20 and a telephone set which connect with RJ11 operating independently form the wireless connection between 10b and 26), and generating a radio frequency signal (see fig.1 number 10b), and to broadcast the messages to a telephone set (see fig.1 the zigzag line between 10b and

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base station 26), the messages are not related to control and program signaling of the telephone set (also see fig.1 the wire-line connection 24 between PSTN 20 and a telephone set which connect with RJ11 is operated independently from the wireless connection between 10b and box 26. Therefore, the messages are not related to control and program signaling of the telephone set).

Regarding claim 3, Zicker further teaches that the wireless signaling channel transmits signals independently (see fig.1 the wireless connection between 10b and base station 26).

Regarding claims 10 and 17, Zicker further teaches a central platform for use in dual signaling channel telephony network, the central platform comprising: the first processor (see fig.1 number 20) to receive incoming messages and transmitted over a wireless channel (see fig.1 wireless connection between 10b and 26), and a central processor authenticating relevant portions of the messages (see column 15, lines 43-51), and a second processor (see fig.1 number 12), and the message are not related to control and program signaling of the telephone set (see fig.1 the wire-line connection 24 between PSTN 20 and a telephone set which connect with RJ11 is operated independently from the wireless connection between 10b and box 26. Therefore, the messages are not related to control and program signaling of the telephone set).

Regarding claim 11, Zicker further teaches a RF translator (see fig.1, block 10b), a server including a database storing user profiles and related information (see fig.1 number 23).

Regarding claim 12, Zicker further teaches a dual signal channel telephone system for use in a telephony network comprising a receiver (see fig.1 number 26) and output device to deliver the messages over a wireless channel to the telephone (see fig.1 RJ-11 connect to number 26), the telephone communication over a wired connection (see fig.1 the wire-line connection 24 between PSTN 20 and a telephone set which connect with RJ11).

Regarding claim 13, Zicker further teaches the output device is at least one of a speaker (see fig.1 the telephone).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zicker et al (US 5,832,378) in view of Gordon (US 5,608,786).

Regarding claim 2, Zicker et al teaches a dual signaling channel telephone system, comprising: a wired signaling channel (see number 24, fig.1) and a telephone set (see a telephone set connect to RJ-11 box, fig.1), a wireless signaling channel including a central platform (see number 12, fig.1) to receive messages from a message

generator (see number 23, fig.1), and to generate a radio frequency signal (see number 10b), and to broadcast the messages to a telephone set (see fig.1 the wireless connection between 10b and 26). Zicker does not specifically disclose the messages are conveyed to the telephone set and include indications, notifications or any information content for delivering via voice mail, e-mail, fax and internet. Gordon teaches the messages are conveyed to the telephone set and include indications, notifications or any information content for delivering via voice mail, e-mail, fax and internet (see column 1, lines 5 to 20). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to provide the above teaching of Gordon to the system Zicker, so that the user has more significantly freedom and choice regarding message retrieval.

5. Claims 4-9,14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zicker et al in view of Perry et al (US 6,160,489).

Regarding claims 4-7,14 and 16, Zicker teaches a dual channel telephone system (see fig.1 wireless connection between 10b and 26, and wire-line 24), comprising: a network receiving messages from message generators (see fig.1 box 23), a central platform broadcasting messages over the wires channel (see fig.1 wireless connection between 10b and 26) based on the messages generated by the message generator, the message generators operating independently from the telephone system (see fig.1 the wire-line connection 24 between PSTN 20 and a telephone set which connect with RJ11 operating independently from the wireless

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connection between 10b and box 26. Therefore, the messages are not related to control and program signaling of the telephone set). Zicker does not specifically disclose an indicating device. Perry teaches the system comprising an indicating device (see fig.2 box 227). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to provide the above teaching of Perry to the system Zicker so that wireless communication device is adapted to generate a plurality of distinctive tactile alert pattern.

Regarding claim 8, Zicker further teaches the messages are supplied to the network in at least one format (see fig.1 the X.25 connection between number 17 and number 23).

Regarding claim 9, the telephone in Zicker inherently includes the limitation "audibly" or "visually".

Regarding claim 15, Zicker further teaches the message from a network accessible device to a central platform (see fig.1 connection of box 12 with PSTN 20 and PC 16), and delivering the message received by the telephone on an output of the telephone (see fig.1 antenna of box 26 and line 24).

Response to Arguments

6. Applicant's arguments filed 06/17/2002 have been fully considered but they are not persuasive.

On page 5 of applicant's remarks, applicant argues that "two distinct (i.e. separate) paths are used for calls and messages and may operate during the same communication."

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., two distinct (i.e. separate) paths are used for calls and messages and may operate during the same communication) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

On page 5 of applicant's remarks, applicant argues that "Additional, the message generator in the present invention is operated independently from the telephone system itself."

In response, Zicker indeed teaches this claimed limitation (see Zicker fig.1 the wire-line connection 24 between PSTN 20 and a telephone set which connect with RJ11 is operated independently from the wireless connection between 10b and box 26. Therefore, the messages are not related to control and program signaling of the telephone set). In addition, Applicant's attention is directed to the rejection of claims 1-17 above.

On page 6 of applicant's remarks, Applicant argues that "Since the recites structure and method is not disclosed by the applied prior art, ..."

The examiner, however, disagrees, the combination of Zicker, Gordon and Perry does indeed teach the structure and method of claims 1-17. In addition, Applicant's attention is directed to the rejection of claims 1-17 above.

On page 6 of applicant's remarks, Applicant argues that Gordon or Perry fails to disclose the dual-mode operation.

The dual-mode operation is taught by Zicker.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703) 308-6739. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Nghi H. Ly



November 7, 2002


11/13/02

NGUYEN T. VO
PRIMARY EXAMINER